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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,325	04/05/2001	Ian Karl Jones	713-488	4159

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EXAMINER

NGUYEN, KIMBERLY T

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 09/12/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,325

Applicant(s)

JONES, IAN KARL

Examiner

Kimberly T. Nguyen

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 4, and 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "the contact surface area" in lines 2 and 3 of the claim. ✓
There is insufficient antecedent basis for this limitation in the claim.

In claim 3, it is not clear what the term "inverse" in the phrase "rear surface pattern being the inverse" means. ✓

The term "substantially" in claims 6 and 7 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. ✓

In claim 9, it is not clear how the sheet has a thickness between the front and rear surfaces which is less than or equal to about 5 times the thickness of the sheet. ✓

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Barnholtz, U.S. Pat. No. 5,830,558.

Barnholtz shows a multiple ply tissue paper comprising continuous network regions with repeating patterns which protrude from the paper and are embossed and arranged in a manner wherein all lines projected onto the surface of the paper cut through the shaped protuberances and gaps in-between (Figure 4 and column 1, lines 22-27). The tissue paper can be used to wrap, package, and protect materials. Barnholtz shows that the front and rear surfaces of the paper have inverse repeating patterns and that the contact surface of the front and rear surfaces are equal (Figure 5). Barnholtz shows that the paper has a front surface, a rear surface, and a middle level comprising connecting webs of paper fibers which connect the shaped protuberances (Figures 4-5 and 9-10). Barnholtz shows that the connecting webs extend in lateral and perpendicular directions to the shaped protuberances and form a mosaic or tessellated pattern (Figures 4-5 and 9-10). Barnholtz shows that the shaped protuberances have rounded and sloped shaping (Figure 5) and can be laminated with another layer (column 1, lines 14-27).

Claim 3 is rejected because the phrase “sheet is embossed to provide” introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims.

Claims 1, 3-7, 9, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Rudy, U.S. Pat. No. 4,287,250.

Art Unit: 1774

Rudy shows a thermoplastic packaging sheet comprising repeated patterns (tessellations) of rounded shaped protuberances and gaps which are positioned such that any straight lines projected onto the surface of the paper cut through the shaped protuberances and gaps in-between (Figure 1). Rudy shows that the repeating patterns are inverses of each other on the front and rear surfaces and that the contact surface areas of both surfaces are equal (Figures 2 and 3). Rudy shows that the sheet comprises a middle level comprising connecting webs adjacent to the shaped protuberances and that the connecting webs extend laterally and perpendicularly to the shaped protuberances (Figures 1, 3, and 4). Rudy shows that the distance between the front and rear surfaces is less than or equal to about 5 times the thickness of the sheet (Figures 2-3 and 5).

Claim 3 is rejected because the phrase "sheet is embossed to provide" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barnholtz, U.S. Pat. No. 5,830,558.

Barnholtz is relied upon as above for claim 1 and 2. Barnholtz does not show that the shaped protuberances are "T" shaped as in instant claim 8; however, the shape or configuration of an invention is a matter of choice which a person of ordinary skill in the art would find obvious absent persuasive evidence that the particular configuration of the claimed invention is significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barnholtz, U.S. Pat. No. 5,830,558 in further in view of McGuire et al., U.S. Pat. No. 6,254,965 B1.

Barnholtz is relied upon as above for claims 1 and 2. Barnholtz does not show that the gaps between the shaped protuberances are filled with foam as in instant claim 10. McGuire shows a nesting-resistant sheet material comprising tessellations and patterns of shaped protuberances wherein the gaps in between the protuberances are filled with foam (column 16, lines 45-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to fill the gaps with foam because it is known that filling with foam helps the sheet to cushion packaged materials.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the

Art Unit: 1774

organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen
Examiner
September 9, 2002

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

A handwritten signature in black ink, appearing to read "Cynthia H. Kelly", with a stylized flourish at the end.